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The opinion in support of the decision being entered today was **not** written for publication
and is **not** binding precedent of the Board.

Paper No. 34

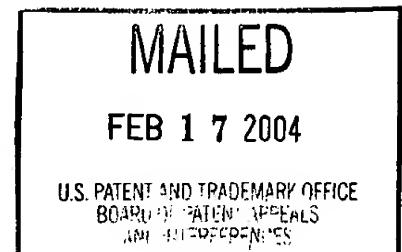
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOYOHICO YOSHIDA and HIDEYUKI FUJII

Appeal No. 2003-1622
Application No. 09/146,259

HEARD: January 21, 2004



Before KRASS, JERRY SMITH, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-25,
which are all of the claims pending in this application.

We REVERSE.

Appellants' invention relates to a data processing device. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A data processing device comprising:

an instruction decoder for sequentially decoding a plurality of instructions described in a program sequence and outputting control signals respectively corresponding to the instructions, and

an instruction execution unit for executing operations respectively designated by said plurality of instructions in accordance with said control signal output from said instruction decoder, wherein

said instruction decoder decodes a first instruction among said plurality of instructions and outputs a first control signal in a first period;

said instruction execution unit executes the operation designated by said first instruction in accordance with said first control signal in a second period succeeding to said first period;

said instruction decoder outputs a second control signal in a third period by decoding a second instruction of which operation is executed under a predetermined condition among said plurality of instructions; and

said instruction execution unit determines whether or not said predetermined condition is satisfied in a fourth period and executes the operation designated by said second instruction in response to a result of the determination, said fourth period being started after elapsing a same time as said second period or longer from an ending of said third period.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

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Holmann et al. (Holmann)

5,815,698¹

Sep. 29, 1998
(Filing date Jan. 27, 1997)

Claims 1-25 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention. Claims 1-25 stand rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. Claims 1-25 stand rejected under 35 U.S.C. § 102 as anticipated or, in the alternative, under 35 U.S.C. § 103 as being obvious over Holmann (JP 08203675).

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 26, mailed Jan. 15, 2003) for the examiner's reasoning in support of the rejections, and to appellants' supplemental brief (Paper No. 25; filed Oct. 17, 2002) and reply brief (Paper No. 29, filed Mar. 14, 2003) for appellants' arguments thereagainst.

¹ Here, we note that the examiner relies upon the teachings of Holmann in the Japanese published patent rather than the US patent to Holmann since the present application and Holmann have one inventor in common. But for ease of application of the prior art, the examiner refers to the teachings of Holmann (the US patent) as the translation of Holmann (Japanese patent) since the US patent claims foreign priority to the Japanese application (patent). Appellants have not objected to the use of the US counterpart patent as representative of an accurate translation of the Japanese patent. Therefore, we will similarly refer to the US patent in our discussion of the prior art.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art reference(s), and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

35 USC § 112, SECOND PARAGRAPH

The examiner maintains that appellants have provided no specific definition to the term "instruction" and have used the term in various inconsistent ways throughout the specification. (See answer at pages 4-7.) Appellants argue that the specification and Figures 2a and 2b clearly describe that the decoder decodes the instruction whether it contains one or two operation codes which are described as "operations" or "sub-instructions." (See brief at pages 14-16.) Appellants argue that the US patent to Holmann uses the same terminology. (See brief at page 16.) While we do not find the similar usage in the patent to be persuasive by itself, we do find that the portions of the instant specification referenced by appellants do clearly shed light as to the various uses of the term "instruction" in the present claims. The examiner goes on at length regarding various interpretations of the claim language, but we do not find that this is a point of indefiniteness. Rather, it appears to be one of breadth of the claim language, which should be addressed with application of prior art under 35 USC §§ 102 and 103. Therefore, we will not sustain the rejection under 35 USC § 112, second paragraph.

35 USC § 112, FIRST PARAGRAPH

The examiner maintains that the present claims lack a critical or essential element to practice the invention. (See answer at pages 7-8.) The examiner goes through a long analysis and evaluation of an attempt to build a superscalar processor and concludes the second time period is a highly variable period which appellants have provided no guidance on. (See answer at pages 8-10.) We find the examiner's analysis confusing with respect to the enablement rejection since the time period may be set at any value greater than the maximum variation and there would be no problem, but the operation may not be optimum. Clearly, the invention would be enabled, but may or may not be optimum in its operation. We do not find this to be a fatal enablement problem for independent claim 1, and we will not sustain the rejection of independent claim 1 and its dependent claims.

Furthermore, we find that independent claims 14 and 21 do not contain the same limitations to the specific periods. Therefore, the examiner's rejection of these claims is untenable. We do find similar limitations in dependent claim 20, but as above we do not find a fatal enablement problem and we will not sustain the rejection of independent claims 14 and 21, and we will not sustain the rejection of independent claims 14 and 21 and their dependent claims.

35 USC § 102

"Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention." **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). **See In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). After the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to the appellant to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. **See In re Thorpe**, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); **In re King**, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, appellants' burden before the PTO is to prove that the applied prior art reference does not perform the functions defined in the claims. Compare **In re Best**, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); **In re Ludtke**, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971). With respect to independent claim 14, the examiner maintains that Holmann teaches all the hardware elements of the processing device. (See answer at page 12.) While we agree with the examiner that the specific hardware elements (instruction decoder and instruction execution unit) are disclosed, the examiner has not addressed the operation of these hardware

elements with respect to the recited claim limitations. Specifically, the examiner has not shown where Holmann teaches a first register for holding a first description indicating a timing of starting a determination of said condition and use of the timing to start the determination of the condition.

Appellants argue that the claims call for a delay in the determining a condition and that the execution of the instruction is not performed until the condition is satisfied after the delay period before the condition is evaluated. (See brief at page 20.) The examiner includes some random program segment which is not disclosed in Holmann as part of the rejection. (See answer at pages 11 and 12.) We do not find this extraneous material useful in the evaluation of the specific disclosure of Holmann. Here, we find that the examiner is speculating and extrapolating from beyond the disclosure of Holmann which is inappropriate in a rejection under 35 USC § 102. Therefore, we cannot sustain the rejection under 35 USC § 102 since the examiner has not established a ***prima facie*** case of anticipation of independent claim 14 and its dependent claims. The examiner relies upon the application of the prior art applied against claim 14 with respect to independent claims 1 and 21. Therefore, we cannot sustain the rejection under 35 USC § 102 since the examiner has not established a ***prima facie*** case of anticipation of independent claims 1, 21 and their dependent claims.

35 USC § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the

claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination `only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). As above, we find that the examiner has not addressed the timing aspect of the claimed invention and while the examiner may use the random program in the analysis of the Holmann system, we find

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no persuasive showing concerning the limitations discussed above. Therefore, we cannot sustain the rejection under 35 USC § 103 since the examiner has not established a *prima facie* case of obviousness of independent claims 1, 14, and 21, and their dependent claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-25 under 35 U.S.C. § 112, second paragraph is reversed, the decision of the examiner to reject claims 1-25 under 35 U.S.C. § 112, first paragraph is reversed, and the decision of the examiner to reject claims 1-25 under 35 U.S.C. § 102 or in the alternative 35 USC § 103 is reversed.

REVERSED


ERROL A. KRASS
Administrative Patent Judge


JERRY SMITH
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge

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